

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---------------------|---|--------------------|-------------------------------|
| Applicants: | Astley <i>et al.</i> | Conf. No.: | 7123 |
| Serial No.: | 10/007,859 | Art Unit: | 2134 |
| Filing Date: | 11/13/2001 | Examiner: | Tolentino, Roderick |
| Title: | METHODS, APPARATUS AND COMPUTER PROGRAMS PERFORMING A MUTUAL CHALLENGE-RESPONSE AUTHENTICATION PROTOCOL USING OPERATING SYSTEM CAPABILITIES | Docket No.: | GB920010085US1 (IBMR-0183) |

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a prima facie case of obviousness based on an error in facts. Claims 1-16 are pending in this application.

In the Final Office Action, claims 1 and 12-15 are rejected under 35 U.S.C. §103(a) as allegedly being anticipated by Gray (U.S. Patent No. 5,844,497), hereafter “Gray,” in view of Laage *et al.* (U.S. Patent No. 6,931,382), hereafter “Laage.” Claims 2 and 6 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gray in view of Laage and further in view of Boyko *et al.* (U.S. Patent No. 7,047,408), hereafter “Boyko.” Claim 3 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gray in view of Laage and further in

view of Patzer (U.S. Patent No. 6,732,270), hereafter “Patzer.” Claims 6-8 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gray in view of Laage and further in view of Davis *et al.* (U.S. Patent No. 6,064,736), hereafter “Davis.” Claim 4, 5 and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gray in view of Laage and further in view of Yatsukawa (U.S. Patent No. 6,148,404), hereafter “Yatsukawa.” Claim 11 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gray in view of Laage and Yatsukawa, and further in view of Davis.

Applicants submit that these rejections are clearly not proper and without basis because at least one claim limitation is not met by the combined features of the references cited by the Office. As argued in the December 26, 2007 Amendment, the cited references fail to teach or suggest each and every element of independent claim 1. In particular, the references cited by the Office fail to teach or suggest that the authentication check is adapted to be performed without having the client password in a cleartext format on the server data processing system. December 26, 2007 Amendment, top of page 10, through page 11, continuation paragraph. The language of Laage that the Office relies upon, that “only the ‘hash’ of the original password is stored in the database,” does not preclude this. This is because even though the storage of the original password may not be in cleartext, the incoming password from the user is. This is borne out elsewhere in Laage, which recites that “[u]pon entering a username and password, the entered information is transmitted to the central server 15, together with the corresponding encrypted information on the CD-ROM 3.” Col. 10, lines 44-46. This passage indicates that while the information on the CD-ROM of Laage is encrypted, the password is forwarded to the central server as entered, i.e., in plain text form. After the cleartext password has been received on the server, “...a hash algorithm then creates a hash of the password submitted by the user and the

server compares the hash from the user and the hash from the database.” Col. 10, lines 53-56.

To this extent, Laage continuously teaches that the password that is entered by the user is received at the server in clear text form. To this extent, contrary to the Office’s arguments, Laage does not teach that the authentication check is adapted to be performed without having the client password in a cleartext format on the server data processing system.

Accordingly, the Office has failed to state a prima facie case of obviousness and this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

With respect to the rejections of independent claims 12-15, Applicants note that each claim includes a feature similar in scope to the features discussed herein with respect to claim 1. Further, the Office relies on the same arguments and interpretations of the cited references as discussed above with respect to claim 1. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 1, and respectfully request withdrawal of the rejections of these claims for the above-stated reasons.

The dependent claims are believed to be allowable based on the above arguments regarding the claims from which they depend, as well as for their own additional features.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

/Hunter E. Webb/

Date: June 20, 2008

Hunter E. Webb
Reg. No.: 54,593

Hoffman Warnick LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

HEW